

Appl. No. 10/825,161
Amendment dated: April 7, 2005
Reply to OA of: January 7, 2005

REMARKS

Applicants have amended the specification and claims to more particularly define the invention taking into consideration the outstanding Official Action. The specification has been amended at pages 4, 5 and 8 to more closely define the invention in accordance with the amended claims and as fully supported by the specification as originally filed and as would be interpreted by one of ordinary skill in the art to which the invention pertains.

The Abstract has been amended and is found at the end of this paper on a separate sheet according to the rules.

Claims 2 and 3 have been canceled without prejudice or disclaimer and the limitations of claims 2 and 3 have been added to claim 1. Applicants most respectfully submit that all the claims now present in the application are in full compliance with 35 U.S.C. §112 and are clearly patentable over the references of record.

The rejection of claims 1 and 3-5 under 35 U.S.C. 103 as unpatentable over Barak et al. in view of Shumiyashu has been carefully considered but is most respectfully traversed. It is not believe that this combination of references establishes a prima case of obviousness as discussed below. However, in an effort to expedite the prosecution of this application to an early allowance, the limitations from claim 2, not included in this rejection have been added to claim 1. In view of the addition of the limitations from claim 2 to claim 1 and since claim 2 was not included in this rejection, therefore the rejection has been obviated by the amendments to the claims. Accordingly, it is most respectfully requested that this rejection be withdrawn.

The rejection of claim under 35 U.S.C. 103 as unpatentable over Barak et al. in view of Shumiyashu Morris et al has been carefully considered but is most respectfully traversed. Applicants wish to direct the Examiner's attention to the basic requirements

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of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal argument and evidence present by applicant and the citation of In re Soni for error in not considering evidence presented in the specification.

The air passage arranged in the shape of "Z" is a very special feature of the presently claimed invention. Experiments have shown that "Z" shape air passage can generate enough shearing stresses to decrease the blood viscosity. This feature is not shown in the prior art.

It is stated in the Official Action that Shumiyashu teaches that it is well known to use magnets applied to the body to improve blood circulation. Further, a modification

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of Barak et al. to include the plurality of magnets would have been obvious since it is prima facie obvious to combine two devices each of which is taught by the prior art to be useful for the same purpose in order to form a third device used for the very same purpose. The Examiner concludes that the idea of combining them flows logically from their having been individually taught in the prior art but this conclusion results in no more than an obvious to try standard of patentability which is not the standard under 35 USC 103 which requires the expectation of success.

In particular, Shumiyashu teaches that the theoretical analysis of those effects is still unknown and there is no suggest that the combination will be effective. Clearly, there is a lack of predictability and expectation of success required for a prima facie case of obviousness. Moreover, the Shumiyashu reference deals with treatment of the lumbar area of the back and not a self-operated mini therapeutic device for venous thrombus prophylaxis including plural air passages and plural magnets defined in an air cushion in accordance with the presently claimed invention.

Furthermore, the arrangement of "Z" shape air passages and magnets is proved by the presently claimed invention to provide a great effect to decrease the blood viscosity in the presently claimed invention. There is no teaching to this specific and presently claimed aspect of the invention, absent Applicants specification which represent impermissible hindsight. In re Fritch, 23 USPQ 1780, 1784(Fed Cir. 1992) ("It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.). Accordingly, it is most respectfully requested that this rejection be withdrawn.

The additional Lin et al reference noted in the Official Action has been reviewed. This reference refers to the use of electromagnetic and not permanent magnets as

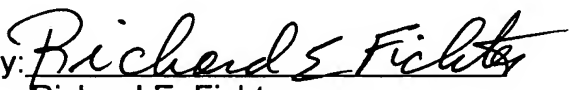
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used in the presently claimed invention. Since the art was not applied, no further comments are deemed necessary.

In view of the above comments and further amendments to the specification and claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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